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REMARKS

Claims 1-4 6-9 and 12-26 are pending in the present Application. Claims 1, 2, 7, 9, 12-15, 17, 22, 23, 26, and 26 have been amended, leaving Claims 1-4 6-9 and 12-26 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-4, 6-9, and 12-26 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claims 1 and 25 have been rejected for allegedly not providing the basis for the amounts of the components with sufficient clarity. While applicants believe that one of ordinary skill in the art would readily understand that the basis for the amounts recited in the claims was 100 parts by weight of the resin composition (as indicated in paragraph [0016]), Applicants have amended the claim to facilitate prosecution. In light of the amendment Applicants request withdrawal of the rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-26 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,777,028 to Okada et al. (Okada), U.S. Patent No. 6,348,540 to Sugioka et al. (Sugioka), EP 1045003 to Kogure et al. (Kogure) or JP 07331057 to Kinoshita et al. (Kinoshita), each independently in combination with EP 509506 to Matsumura et al. (Matsumura). Applicants respectfully traverse these rejections.

Okada discloses an impact resistant polystyrene composition comprising a syndiotactic polystyrene, a rubbery elastomer, and a styrene/olefin block or graft copolymer. (Abstract) The composition may optionally comprise a polyphenylene ether in an amount of 0.5 to 5.0% by weight (Col. 5, lines 1-54). Matsumura is directed to organic diphosphates.

The pending claims require at least twice the amount of poly(arylene ether) than is disclosed by Okada and Matsumura does not overcome this deficiency. For an obviousness

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rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Applicants respectfully assert that a prima facie case of obviousness has not been established because neither Okada nor Matsumura disclose the claimed amount of poly(arylene ether).

As indicated by the Examiner Sugioka broadly discloses at Col. 3, lines 15-21 a composition comprising component (A) and optionally component (B), component (E), component (F), and the component (G). In citing this section of Sugioka Applicants respectfully assert that the Examiner has failed to consider the totality of the reference.

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

Sugioka discloses, with great specificity, particular combinations of components (A) through (G). Sugioka discloses, in one embodiment, a syndiotactic resin composition comprising (A) a syndiotactic styrenic polymer, (B) a rubber-like elastomer having an affinity for (A), and (E) a polymer having compatibility with or affinity for (A). (Col. 2, lines 13-26) Examples of rubber-like elastomers (B) include hydrogenated styrene-butadiene-styrene block copolymer but does not include ethylene-octene elastomers. (Col. 4, lines 26-56) Ethylene-octene elastomers are only explicitly described as component (G). Examples of (E) include polyphenylene ether.

In another embodiment Sugioka discloses a styrenic composition comprising (A) a syndiotactic styrenic polymer and (G) a polyolefin having a melt index of at most 25 grams/10 minutes. (Col. 2, lines 56 to 67). Examples of (G) include ethylene-octene copolymer elastomer.

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(Col. 6, lines 49-50) Sugioka does not disclose the inclusion of a poly(arylene ether) or a hydrogenated styrene-butadiene block copolymer in this embodiment.

Furthermore, Sugioka does not teach the relative amounts of the components except in the context of specific embodiments 1-5 as shown at Col. 9, line 13 to Col. 10, line 30. Accordingly, it's clear that Sugioka does not contemplate the composition instantly claimed. Sugioka does not explicitly disclose a composition that comprises a syndiotactic polystyrene, a hydrogenated styrene-butadiene block copolymer, an ethylene-octene elastomer and a poly(arylene ether) as is instantly claimed. Sugioka discloses embodiments that employ some of the same elements as are instantly claimed but Sugioka does not teach or suggest an embodiment which contains all of the claimed elements. Matsumura does not remedy this deficiency.

Applicants respectfully assert that in making the rejection the Examiner has failed to consider the totality of the reference. Sugioka explicitly, and with great detail, sets out 5 specific compositions, and does not reasonably teach or suggest alternate combinations of the components found in these five compositions. The Examiner, using hindsight gained from the present application, has reinterpreted the teachings of Sugioka and in doing so has not applied the teachings of the art in the context of their significance to a technician at the time.

Kogure discloses a composition comprising (A) a syndiotactic polystyrene, (B) an olefinic polymer and (C) a compound miscible with or having an affinity for component (A) and (B). (Abstract) Examples of component (B) include ethylene-octene copolymer elastomer. ([0021]) Examples of (C) include hydrogenated styrene-butadiene block copolymer. ([0022]) The composition may include several optional ingredients including polyphenylene ether. ([0028]) Kogure however, only contains a very general teaching with regard to the amount of polyphenylene ether and does not teach or suggest that an amount of polyphenylene ether t be used. In fact, Kogure states that the amount is not specifically defined.

The Examiner has expressed the opinion that a prima facie case of obviousness is supported by the assertion that it would have been obvious for one of ordinary skill in the art to determine a "workable or even optimum range". Applicants vigorously disagree. Kogure provides absolutely no guidance as to amounts polyphenylene ether. Without some amount of guidance there can be no optimization. In fact, without any guidance at all Kogure is not

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sufficiently enabling for the inclusion of polyphenylene ether particularly given the complex nature of the compositions described in Kogure.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-1131.

Respectfully submitted,

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